

Remarks

Claims 24, 35, 37, 46-47, and 105-106 have been amended without any intention of disclaiming equivalents thereof. Claims 33-34 and 44-45 have been cancelled without prejudice to their subsequent reintroduction into this application or their introduction into a related application. New claims 107-116 have been added. Upon entry of this paper, claims 24, 26-32, 35-37, 39-43, 46-48, and 104-116 will be pending and under consideration.

Applicants wish to thank the Examiner for acknowledging that claims 33, 35, 45-47, and 105-106 are free of the prior art and that claims 33, 35, 45, 46, and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. (Office action, pages 24-25.) Accordingly, without acquiescing to the rejections indicated in the Office action, but in order to expedite prosecution, Applicants have amended independent claim 24 to incorporate, among other things, the subject matter of claims 33 and 34, and have amended independent claim 37 to incorporate, among other things, the subject matter of claim 45. Claims 33-34 and 44-45 have been cancelled, and the dependencies of claims 35 and 47-48 have been amended accordingly. In addition, independent claims 24, 37, 105, and 106 have been amended to recite production of a reaction product "without the assistance of a ribosome." Support for this amendment appears throughout the application as filed, for example, at paragraph [0250] of the application as filed.

New independent claim 107 combines the subject matter of independent claim 24 and dependent claim 35. New dependent claims 108-116, which depend directly or indirectly from independent claim 107, correspond to dependent claims 26-33, 36, and 104. Applicants believe that the aforementioned amendments and new claims introduce no new matter. The outstanding objections and rejections are addressed in the order in which they appear in the Office Action.

Double Patenting Rejections

According to pages 3-6 of the outstanding Office Action, certain claims presently stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over certain claims in U.S. Patent Number 7,070,928, in view of PCT Publication No. WO

00/61775 by Sergeev (hereinafter "Sergeev"), and over certain claims in U.S. Patent Application Serial Nos. 11/586,851 and 10/949,163. Applicants respectfully submit that U.S. Patent Application Serial No. 11/586,851 has now lapsed. Accordingly, Applicants respectfully request that the double patenting rejection based upon the '851 application be reconsidered and withdrawn. Regarding the rejection in view of U.S. Patent Number 7,070,928 or U.S. Patent Application Serial No. 10/949,163, now U.S. Patent No. 7,223,545, Applicants, without acquiescing to the merits of the rejection based upon these patents, enclose a Terminal Disclaimer to obviate this rejection. Accordingly, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 103

According to pages 7-15 of the outstanding Office action, claims 24, 26-32, 34, 36-37, 39-44, 48, and 104 presently stand rejected under 35 U.S.C. § 103 as being obvious over Sergeev in view of Gartner and Liu (2001) J. Am. Chem. Soc. 123: 6961-63 (and supporting information), and in view of U.S. Patent No. 5,888,819 by Goelet *et al.* Moreover, according to pages 15-22 of the outstanding Office Action, claims 24, 28, 30-34, 36-37, 41-45, 48, and 104 presently stand rejected under 35 U.S.C. § 103 as being obvious over Dörner *et al.* (1984) Virology 50 (3): 507-514, as evidenced by Brooker (1999) GENETICS ANALYSIS AND PRINCIPLES (1st Ed.), Menlo Park, CA, in view of U.S. Patent No. 5,888,819 by Goelet.

According to pages 24-25 of the outstanding Office action, the Office has acknowledged that dependent claims 33, 35, 45-47, and independent claims 105-106 are free of the prior art. Without acquiescing to the foregoing rejections or the Office's characterization of the claimed invention relative to the teachings of Sergeev, but solely in order to expedite prosecution, Applicants have amended independent claims 24 and 37 to incorporate, among other things, the subject matter of claims 33-34 and claim 45, respectively. New independent claim 107 includes the subject matter of claim 35. Accordingly, because all the pending claim now include, by amendment or by dependency, subject matter that the Office has indicated is free of the prior art, Applicants respectfully request that the foregoing rejections under 35 U.S.C. § 103 be reconsidered and withdrawn.

Conclusion


Applicants believe that, in the view of the above amendments and comments, the pending claims are in condition for immediate allowance. Early favorable action is respectfully solicited. The Office is invited to contact the undersigned with any questions about this submission.

Respectfully submitted,

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